APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,163	07/14/2003	Takashi Hasebe	KOY-0007	9495

7590   01/28/2008

Lisa A. Bongiovi
55 Griffin South Road
Bloomfield, CT 06002

EXAMINER
CHUONG, TRUC T

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
01/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
		10/620,163	HASEBE ET AL.
Office Action Summary		Examiner	Art Unit	
		Truc T. Chuong	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE·OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 November 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-49</u> is/are pending in the application.

    4a) Of the above claim(s) <u>37-49</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/30/07 and 03/26/07</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

This is a first office action is responsive to the document, filed 07/14/03.

Claims 1-36 are pending in this application, claims 1-36 are elected from original claims

1-49, and claims 1, 15-17, 22, and 29 are independent claims. This action is made non-final.

Election/Restrictions

1.   Applicant's election with traverse of Group I (claims 1-36), filed 11/09/07, is

acknowledged. Because applicant did not distinctly and specifically point out the supposed errors

in the restriction requirement, the election has been treated as an election without traverse

(MPEP § 818.03(a)). Therefore, the requirement for restriction is proper and hereby made

FINAL.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3.   Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keane et al.

("Keane", U.S. Pub. No. 2004/0003342 A1).

As to claims 1, 17, 22, and 29, Keane teaches an image forming apparatus comprising:

a storing section for storing data in a storage medium (e.g., storages 20 and 22 of fig. 1A,

1, and [0050], [0052]);

an image forming section for forming and printing an image based on data (e.g., figs. 4l

and 4k);

a connector to which a communication terminal is connected (e.g., computer(s) connects

with servers via Internet, [0047-0050]);

a communication control section for controlling the communication terminal connected to

the connector (a browser interface is used to operate the printing processes, e.g., [0056], [0067-

0068]), and

communicating with a server for managing data of various information on a network

(e.g., Print Job Managing System 10, [0048-0050]);

an obtaining section for obtaining desired first data and second data from the server (e.g.,

[0068-0069], and figs. 4l-k); and

a first selecting section for selecting an output state of the first data and the second data

obtained by the obtaining section (e.g., [0068-0069], and figs. 4l-m); and

wherein the apparatus provides the first data and the second data in the output state

selected by the first selecting section (e.g., [0068-0069], and figs. 4l-m);

although, Keane teaches the print job control can be run on personal computers or other

electronic devices (e.g., [0048], and figs. 1-1a-b). Keane does not clearly teach that the terminal

is a portable terminal. It is well known and would have been obvious to a person of ordinary skill

in the art at time of the invention to use portable/mobile devices such as a Laptop, PDA, Palm, or

cell phone, etc. because these mobile/portable devices is fully capable of perform a similar

functions as the personal computers or other electronic devices as mentioned above in order to

provide more convenience to the user when using and carrying the mobile/portable device in

travel, out of the job sites/offices/countries, etc.

As to claim 2, Keane teaches the apparatus of claim 1, wherein the first selecting section

selects a first output state for storing the first data and the second data in the storage medium,

and the storing section stores the first data and the second data in the storage medium (e.g.,

storages 20 and 22 of fig. 1A, 1, and [0050], [0052]; [0068-0069], and figs. 4l-m).

As to claim 3, Keane teaches the apparatus of claim 1, wherein the first selecting section

selects a second output state for storing the first data in the storage medium and printing the

second data in a predetermined print condition predetermined by the apparatus, the storing

section stores the first data in the storage medium, and the image forming section prints the

second data in the predetermined print condition predetermined by the apparatus (e.g., [0097-

0099]).

As to claim 4, Keane teaches the apparatus of claim 1, wherein the first selecting section

selects a third output state for storing the first data in the storage medium and printing the second

data in a desired print condition, the storing section stores the first data in the storage medium,

and the image forming section prints the second data in the desired print condition (Design Studio, e.g., [0069-0070]).

As to claim 5, Keane teaches the apparatus of claim 3, further comprising a post-processing section for performing post-processing to printed matter obtained by forming and printing the image based on the second data by the image forming section (e.g., [0068-0069], and figs. 4l-m).

As to claim 6, Keane teaches the apparatus of claim 4, further comprising a post-processing section for performing post-processing to printed matter obtained by forming and printing the image based on the second data by the image forming section (e.g., [0050], [0052]; [0068-0069], and figs. 4l-m).

As to claim 7, Keane teaches the apparatus of claim 3, wherein the image forming section comprises a first image forming section and a second image forming section for forming images in different ways, and the apparatus further comprises a second selecting section for selecting any one of the first image forming section and the second image forming section as the image forming section for forming and printing the image based on the second data (e.g., [0050], [0052]; [0068-0069], and figs. 4l-m).

As to claim 8, Keane teaches the apparatus of claim 4, wherein the image forming section comprises a first image forming section and a second image forming section for forming images in different ways, and the apparatus further comprises a second selecting section for selecting any one of the first image forming section and the second image forming section as the image forming section for forming and printing the image based on the second data (e.g., [0068-0069], and figs. 4l-m).

As to claims 9-10, Keane teaches the apparatus of claim 7, wherein the first image forming section forms the image according to at least an inkjet system, and the second image forming section forms the image according to at least an electro-photographic system (the examiner will take official notice of these limitations because the different kind of printers/presses or other printing devices can be used to perform a similar function as the printers of Keane).

As to claim 11, Keane teaches the apparatus of claim 1, further comprising a third selecting section for selecting any one storage medium from an optical storage medium, a magnetic storage medium, an optical magnetic storage and a semiconductor storage medium as the storage medium in which at least one of the first data and the second data are stored by the storing section (e.g., [0092-0097]).

As to claim 12, Keane teaches the apparatus of claim 1, further comprising a calculating section for calculating a charge for provision of the first data and the second data, wherein the communication control section informs the server of the charge calculated by the calculating section by controlling the portable communication terminal (e.g., [0016]).

As to claim 13, Keane teaches the apparatus of claim 1, wherein the first data include music data, and the second data include related information data comprising at least one of text data and image data, concerning the music data (the examiner will take official notice of these limitations because the different kind of data information could be retrieved from the servers via the Internet including music, text, document, etc.).

As to claim 14, Keane teaches the apparatus of claim 1, wherein the storing section attaches electronic watermark data to at least one of the first data and the second data to be stored

in the storage medium, when storing the at least one of the first data and the second data in the

storage medium (the examiner will take official notice of these limitations because the different

kind of designs could be done to the data/images/documents/files/HTML, etc.).

As to claim 15, it can be rejected under a similar rationale as claim 1 above.

As to claim 16, Keane teaches an image forming apparatus comprising:

a storing section for storing data in a storage medium e.g., storages 20 and 22 of fig. 1A,

1, and [0050], [0052]);

an image forming section for forming and printing an image based on data (e.g., figs. 4l

and 4k);

a connector to which a portable communication terminal is connected; a communication

control section for controlling the portable communication terminal connected to the connector,

and communicating with a server for managing data of various information on a network; and an

obtaining section for obtaining desired first data and second data from the server (see claim 1

above);

wherein the storing section stores the first data obtained by the obtaining section in the

storage medium, and the image forming section prints the second data obtained by the obtaining

section in a desired print condition (Design Studio, e.g., [0069-0070]).

As to claims 18-21, they can be rejected under a similar rationale as claims 2-4, and 13.

Note the rejections of claims 2-4, and 13 above respectively.

As to claim 23, Keane teaches the apparatus of claim 22, wherein the image forming

section comprises a plurality of image forming sections for forming images in different ways,

and the apparatus further comprises a selecting section for selecting an image forming section for

forming the image based on the provided article data from the plurality of image forming

sections according to a rate of full-color photograph data included in the provided article data

received by the receiving section (Design Studio, e.g., [0069-0070]).

As to claim 24, Keane teaches the apparatus of claim 22, wherein the account includes at

least one of authentication information and identification information of the portable

communication terminal (user login, table, [0097]).

As to claim 25, it is similar in scope to claim 14 above.

As to claim 26, Keane teaches the apparatus of claim 22, further comprising a post-

processing section for performing post-processing to printed matter of the image formed by the

image forming section (see claim 5 above).

As to claims 27-28, Keane teaches the apparatus of claim 26, wherein the post-processing

section performs at least one of punch processing for punching a binding hole at a predetermined

position of the printed matter, stapling processing for stapling the printed matter, trimmer

processing for trimming the printed matter in predetermined size, pamphlet preparing processing

for preparing a pamphlet, and biding processing for biding the printed matter simply, as the post-

processing (Design Studio, e.g., [0063], [0068], and [0071]).

As to claim 30, it is similar in scope to claim 23 above.

As to claim 31, Keane teaches the system of claim 29, wherein the server further

comprises:

a second storage section for classifying and storing a plurality of stored article data in a

predetermined classified condition therein (e.g., storages 20 and 22 of fig. 1A, 1, and [0050],

[0052]; [0068-0069], and figs. 4l-m);

a determination section for determining an extract condition for every account stored in

the first storage section (e.g., [0092-0097]); and

a storage control section for extracting stored article data satisfying the extract condition

determined by the determination section, from the plurality of stored article data stored in the

second storage section (e.g., [0092-0097]).

As to claim 32, Keane teaches the system of claim 31, wherein the first storage section of

the server stores an electronic mail address related to each of the accounts therein, and the server

further comprises a sending section for reading the electronic mail address corresponding to the

account out of the first storage section when the storage control section completes extracting and

storing the stored article data based on the account, and sending a predetermined electronic mail

to the electronic mail address read (using email, e.g., [0089]).

As to claims 33-36, they are similar in scope to claims 24-27; therefore, rejected under a

similar rationale.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The

examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Truc T. Chuong

01/18/08

WEILUN LO
SUPERVISORY PATENT EXAMINER